

In Re the Appln. of: James J. Barnat et al.
Appln. No.: 09/873,800

REMARKS

The Office Action dated January 31, 2003, has been carefully considered. In the Office Action, the Patent Examiner rejected claims 1-25, 38-51, 53-55, and 60-72. Claims 52 and 56-59 were indicated to contain allowable subject matter, but were objected to as being in a dependent format. In response, Applicant submits herewith a §131 Affidavit to swear behind the cited Terry reference. New claims 73-75 are also presented herewith. Applicant respectfully requests reconsideration and further examination of the application in view of the enclosed Affidavit and the following remarks.

All of the rejected claims were rejected as obvious over Terry, U.S. Patent No. 6,442,258 in view of O'Brien and/or other references. Apparently, the Patent Examiner asserts that Terry qualifies as prior art under § 102(e) as the patent issuance date is after the filing date of Applicant's patent application, but it has an earlier filing date. In response, Applicant submits herewith a § 131 Affidavit to swear behind Terry thereby disqualifying Terry as a citable reference against Applicant's patent application. The relevant section is MPEP § 715 which relates to swearing behind a reference and the submission of an Affidavit or Declaration under 37 C.R.F. § 1.131.

The enclosed Affidavit clearly demonstrates that the present invention was completed and actually reduced to practice prior to July 14, 2000, which is the filing date of the cited Terry reference. The Declaration includes pictures showing that roadway paving apparatus and methods of the invention were completed, tested and prepared a roadway surface prior to the relevant date. There can be no other conclusion based on the § 131 Affidavit that is submitted herewith but that Applicant's invention was actually reduced to practice prior to July 14, 2000 (which is the effective date of the cited Terry reference) and therefore, the cited Terry reference is disqualified and not citable against Applicant's invention pursuant to MPEP § 715 and 37 C.F.R. § 1.131. In light of the § 131 Affidavit that is submitted herewith, all obviousness rejections in the Office Action are now moot because one of the references required in making the asserted combination (namely the principal reference) has been disqualified. Therefore, Applicant respectfully requests removal of all outstanding rejections and the issuance of a Notice of Allowance.

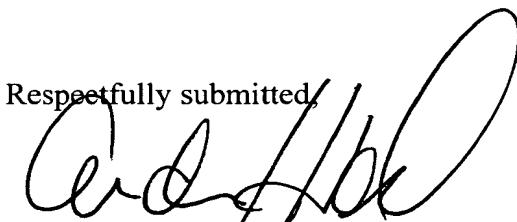
In Re the Appln. of: James J. Barnat et al.
Appln. No.: 09/873,800

It should be noted for the record that the § 131 Affidavit has been signed by all inventors except for Harold Dabbs. Mr. Dabbs is no longer an employee of one of the assignees, E.D. Etnyre & Co., and is therefore believed to be "unavailable" within the meaning of MPEP § 715.04. Because Mr. Dabbs is not readily available as he no longer works for E.D. Etnyre & Co., the absence of his signature would appear to be excusable under MPEP § 715.04 since the other readily available inventors have signed the Affidavit. If, however, the Patent Examiner requires the Affidavit signed by Mr. Dabbs as well, an attempt can be made and the Applicant requests a telephone call from the Patent Examiner.

Conclusion

The application is considered in good and proper form for allowance, and the Examiner is respectfully requested to pass this application to issue. If, in the opinion of the Examiner, a telephone conference would expedite the prosecution of the subject application, the Examiner is invited to call the undersigned attorney.

Respectfully submitted,



Andrew J. Heinisch, Reg. No. 43666
LEYDIG, VOIT & MAYER, LTD.
6815 Weaver Road, Suite 300
Rockford, Illinois 61114-8018
(815) 963-7661 (telephone)
(815) 963-7664 (facsimile)

Date: April 29, 2003

In Re the Appln. of: James J. Barnat et al.
Appln. No.: 09/873,800

CERTIFICATE OF MAILING

I hereby certify that this RESPONSE TO OFFICE ACTION (along with any documents referred to as being attached or enclosed) is being deposited with the United States Postal Service on the date shown below with sufficient postage as first class mail in an envelope addressed to: Commissioner for Patents, Washington, D.C. 20231.

Date: 4-29-03 